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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/628,940 | 07/28/2003 | Paul Newstead | 0338 | 9095 |
| 26612 | 7590 | 12/03/2007 | | |
| DANIEL B. RUNK 1400 PROVIDENT TOWER ONE EAST FOURTH STREET CINCINNATI, OH 45202 | | | EXAMINER MCCORMICK, GABRIELLE A | |
| | | | ART UNIT 3629 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|--|--|--|--|
| <p align="center">Office Action Summary</p> | <p>Application No.</p> <p align="center">10/628,940</p> | <p>Applicant(s)</p> <p align="center">NEWSTEAD ET AL.</p> | |
| | <p>Examiner</p> <p align="center">Gabrielle McCormick</p> | <p>Art Unit</p> <p align="center">3629</p> | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>7/28/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on July 28, 2003.
2. Claims 1-20 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on July 28, 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Drawings

4. The drawings are objected to because they contain numerous handwritten annotations. Figures 26A-30B are completely hand drawn. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 1 contains the phrase "the recipient" in line 1. There is insufficient antecedent basis for this limitation. Further, the claim specifies limitations regarding "users". It is unclear what the relationship, if any, is between the "recipient" and the "users". Claims 2-12 are rejected as a result of their dependency to this claim.
8. Claim 13 contains the phrase "the final recipient" in line 16. There is insufficient antecedent basis for this limitation. Further, the claim specifies limitations regarding "users". It is unclear what the relationship, if any, is between the "final recipient" and the "users".
9. Claim 14 contains the phrase "the final recipient" in line 1; "the document templates" in line 4; "said documents" in lines 5, 10 and 11; "said designed documents" in lines 7 and 9; and "said end users" in line 8. There is insufficient antecedent basis for these limitations. It is unclear what the relationship, if any, is between the "final recipient" and the "end users". It is also unclear what the differentiation is between "designing document templates" and "said designed documents". Claims 15-20 are rejected as a result of their dependency to this claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-7, 10, 12-18 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by

Cincom.com (pages documented at the Internet Archive from June 5, 2002:

<http://web.archive.org/web/20011101131743/www.cincom.com/idsolutions/idsoftware.htm>

("Issues")

<http://web.archive.org/web/20020106024608/www.cincom.com/idsolutions/software/products3.htm>

m; ("iD Web"); [http://web.archive.org/web/20020423034850/www.cincom.com/idsolutions/2000-](http://web.archive.org/web/20020423034850/www.cincom.com/idsolutions/2000-issue-1.htm)

[issue-1.htm](http://web.archive.org/web/20020423034850/www.cincom.com/idsolutions/2000-issue-1.htm) ("Dialogue-Issue 1")

[http://web.archive.org/web/20011101124216/http://www.cincom.com/idsolutions/current-](http://web.archive.org/web/20011101124216/http://www.cincom.com/idsolutions/current-issue.html)

[issue.html](http://web.archive.org/web/20011101124216/http://www.cincom.com/idsolutions/current-issue.html). ("Dialogue-Issue 3")).

12. **Claims 1 and 13:** Cincom.com discloses a correspondence system where business rules determine what information is "captured" at design (defines the static sections) and additionally allows for prompting for optional information (defines the variable sections) during document template design. (Dialogue-Issue 3; pg. 6; para. 1 and 2). Cincom.com further discloses "iD Web Document Services" to "Generate personalized communication using the World Wide Web" (iD Web; pg. 1) including user IDs and passwords (ID and passwords are employed as a means of assessing the user's authorization level-iD Web; pg. 3) and provides management review based on User ID; features "Complete document security" (defines security level for document review

and generation— iD Web; pg. 2) and includes “Point-and-click selection of text...” (user selects an information key-iD Web; pg. 2).

13. **Claim 14:** Cincom.com discloses a correspondence system where business rules determine what information is “captured” at design (defines the static sections) and additionally allows for prompting for optional information (defines the variable sections) during document template design. (Dialogue-Issue 3; pg. 6; para. 1 and 2). Cincom.com further discloses “iD Web Document Services” to “Generate personalized communication using the World Wide Web” (iD Web; pg. 1) including user IDs and passwords (ID and passwords are employed as a means of assessing the user’s authorization level-iD Web; pg. 3) and provides management review based on User ID; features “Complete document security” (defines security level for document review and generation— iD Web; pg. 2). Cincom.com discloses defining security level for documents and sections (Dialogue-Issue 1; pg. 10; para. 1: “ability to set security at the paragraph level (e.g., paragraphs with wording that needs approval), around the individual(s) who can add free-form text, and at the individual level to route all generated letters for review...”); documents are made available based on authorization within a grouping of documents (Dialogue-Issue 1; pg. 10; para. 6: “automatically route certain letters to a supervisor for approval...” (approval by a supervisor would inherently require authorization)); sending generated letters (Dialogue-Issue 1; pg. 10; para. 6) and storing generated letters (Dialogue-Issue 1; pg. 11; 2nd bullet).
14. **Claim 2:** Cincom.com discloses a workflow approval process involving a variety of people with varying degrees of technical knowledge that can be automated that ensures that new information is monitored and controlled. (Dialogue-Issue 3; pg. 11; para. 3) and setting security levels for routing letters for review (Dialogue-Issue 1; pg. 10; para. 1).
15. **Claim 3:** Cincom.com discloses, “send generated letters...via e-mail...” (Dialogue-Issue 1; pg. 10; para. 6).
16. **Claim 4:** Cincom.com discloses a correspondence system where business rules (inherent logic) determine what information is “captured” at design (defines the static sections) and additionally allows for prompting for optional information (defines the variable sections) during document

- template design. (Dialogue-Issue 3; pg. 6; para. 1 and 2) and prompting for "variable data input" (Dialogue-Issue 1; pg. 10; para. 2)
17. **Claim 5:** Cincom.com discloses, "As the database is updated, document content and format respond automatically" (Issues; pg. 3); and archiving documents using the Web. (Dialogue-Issue 1; pg. 11; para. 2).
 18. **Claims 6, 7, 16 and 17:** Cincom.com discloses both a Web interface and an "Ultra-thin client" interface. (iD Web; pg. 2).
 19. **Claim 10:** Cincom.com discloses an interface to SAP R/3 (third party data source) that allows linking to data sources for customized (variable) content. (Dialogue-Issue 3; pg. 13; para. 1).
 20. **Claim 12:** Cincom.com discloses setting security levels for routing letters for review (Dialogue-Issue 1; pg. 10; para. 1) and "send generated letters...via e-mail..." (Dialogue-Issue 1; pg. 10; para. 6).
 21. **Claim 15:** Cincom.com discloses Cincom intelligent Document (iD) that includes setting security levels (i.e., access); printing options and templates for building documents (controls formatting) (Dialogue-Issue 1; pg. 10; para 1, 3 and 4).
 22. **Claim 18:** Cincom.com discloses user IDs and passwords (iD Web; pg. 3).
 23. **Claim 20:** Cincom.com discloses sending generated letters via e-mail or fax (Dialogue-Issue 1; pg. 10; para. 6).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claim 11** is rejected under 35 U.S.C. 103(e) as being unpatentable over Cincom.com (pages documented at the Internet Archive from June 5, 2002:

<http://web.archive.org/web/20011101131743/www.cincom.com/idsolutions/idsoftware.htm>

("Issues")

<http://web.archive.org/web/20020106024608/www.cincom.com/idsolutions/software/products3.htm>;

("iD Web"); <http://web.archive.org/web/20020423034850/www.cincom.com/idsolutions/2000-issue-1.htm> ("Dialogue-Issue 1")

<http://web.archive.org/web/20011101124216/http://www.cincom.com/idsolutions/current-issue.html> ("Dialogue-Issue 3")).

26. **Claim 11:** Cincom.com discloses using their products to create various types of documents: claims letters, call center documents, insurance policies, bills, invoices, etc. (Issues; pg. 2; para. 6, 7 and 8). Cincom.com does not disclose how the selection of the various documents takes place, however, it is obvious that the "point-an-click" feature disclosed in iD Web, pg. 2, would be used to select a document type as this is an efficient and accurate means of creating documents.
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a selection of document types, in the system disclosed by Cincom.com, for the motivation of producing accurate documents in a cost effective manner.

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28. **Claims 8, 9 and 19** are rejected under 35 U.S.C. 103(e) as being unpatentable over Cincom.com (pages documented at the Internet Archive from June 5, 2002:
<http://web.archive.org/web/20011101131743/www.cincom.com/idsolutions/idsoftware.htm>
("Issues")
<http://web.archive.org/web/20020106024608/www.cincom.com/idsolutions/software/products3.htm>; ("iD Web"); <http://web.archive.org/web/20020423034850/www.cincom.com/idsolutions/2000-issue-1.htm> ("Dialogue-Issue 1")
<http://web.archive.org/web/20011101124216/http://www.cincom.com/idsolutions/current-issue.html> ("Dialogue-Issue 3")) in view of Business Wire ("BindView Development Unveils by-Control For SAP Systems; BindView Extends Award-Winning IT Risk Management Products to ERP Market". Business Wire. New York: Sept. 13, 1999. pg. 1).
29. **Claims 8 and 19:** Cincom.com discloses an interface to SAP R/3 (*third party software*). (Dialogue-Issue 3; pg. 13; para. 1). Cincom.com does not disclose SAP providing *security level authorizations* or a *security access code*.
30. Business Wire, however, discloses SAP's "ID Management" that includes passwords and ensuring "that the capabilities assigned to users are consistent with the business process requirements." (pg. 2; para. 8).
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included SAP passwords, as disclosed by Business Wire, in the system disclosed by Cincom.com, for the motivation of automating the addition of new users into SAP that reduces deployment time. (Business Wire; pg. 2; para. 8).
32. **Claim 9:** Cincom.com discloses using XML for documents. (Dialogue-Issue 3; pg. 5; para. 3).


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is 571-270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gabrielle McCormick
Patent Examiner
Art Unit 3629

